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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/587,610

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EXAMINER

BELLAMY, TAMIKO D

ART UNIT

PAPER NUMBER

2856

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,610	Applicant(s) MAZUYER ET AL.	
	Examiner TAMIKO D. BELLAMY	Art Unit 2856	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-26, 33 and 34 is/are rejected.
- 7) ☒ Claim(s) 27-32 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/13/07; 7/28/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Preliminary amendment dated 7/28/06 has been received and entered. Claims 17-35 are currently pending.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **15 and 24 (See figs. 3 and 4)**. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 23 recites the limitation "the fluid" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 17-24, 33, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Corrias et al. (6,776,048).

Re claim 17, as depicted in figs. 1-3 Corrias et al. discloses a first support assembly (22-26, and 38) receiving a central test piece (e.g., central specimen 41), and to drive (e.g., gear train 38) it in rotation about its axis (Col. 5, lines 60-67). a second support (e.g., module 8) is configured to receive three peripheral test pieces (e.g., peripheral specimens 51) and to enable the central test piece (e.g., central specimen 41) to come simultaneous into contact with the three peripheral pieces (51) (Col. 4 lines 37-38), such that while being driven in rotation (e.g., gear train 38) the central test piece (e.g., central specimen 41) can rub against the three peripheral test pieces (51) (Col. 4, lines 37-67; Col. 5, lines 60-67). The second support assembly (e.g., module 8) comprises three support parts (e.g., slides 59) each carrying a respective peripheral test piece (e.g., peripheral specimens 51) (Col. 4, lines 51-52). The three support parts (e.g., slides 59) are movable relative to the other two (Col. 5, lines 49-53).

Re claims 18 , 33, and 34, at least one of the three peripheral test pieces (e.g., peripheral specimens 51), presents a shape selected in such a manner as to enable contact

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with the central test piece (e.g., central specimen 41) to be linear (Col. 4, lines 37-38; Col. 5, lines 60-67; col. 6, lines 1-2).

Re claim 19, the three peripheral test pieces (e.g., peripheral specimens 51) comprise a plane face (e.g., lateral surface 50) whereby it rubs against the central test piece (41) (Col. 4, lines 37-38; Col. 5, lines 60-65).

Re claim 20, as depicted in figs. 2 and 3, the three peripheral test pieces (51) form a plate.

Re claim 21, the contacts {e.g., lateral surfaces (50) of (51) and lateral surfaces (49) of (41)} between the peripheral test pieces (51) and the central test piece (41) are distributed at equal angles around the central test piece (41) (Col. 4, lines 37-45) (See figs 2 and 4).

Re claim 22, the support parts (e.g., slides 59) are configured to form a cavity {figs 2 and 3, see space define by the inner surface wall of each slide (59) that surrounds part of peripheral specimens (51) and the central specimen (41)} suitable for containing a fluid, in particular a lubricant (Col. 6, lines 50-54).

Re claim 23, Corrias et al. discloses a circuit (e.g., oil in module 8) for circulation of the fluid/lubricant in the cavity (Col. 6, lines 47-54).

Re claim 24, Corrias et al. discloses a loading application device {e.g., combination of single-acting diaphragm actuator (80) connected to box (16) and for moving a rod (81) along axis (82)} configured to apply force on at least one of the support parts (e.g., slide 59) (Col. 5, lines 38-49).

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corrias et al. (6,776,048).

Re claims 25 and 26, as depicted in figs. 1 and 2, the load application comprises three pushers (e.g., rods 81) for exerting a force on each of the respective support parts (59), and each pusher is driven by an actuator (80). **While the actuator does not comprise a hinged arm secured at one end to a stationary portion of the tribometer, and its other end to a moving drive member,** the function of the actuator (80) is the same to provide a means of driving the pusher towards the support part (59). It is well established that a recitation with respect to the manner in which an apparatus is intended to be employed, *i.e.*, a functional limitation, does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim. In re Pearson, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 136 USPQ 458 (CCPA 1963). Where the prior art reference is inherently capable of performing the function described in a functional limitation, such functional limitation does not define the claimed apparatus over such prior art reference, regardless of whether the prior art reference explicitly discusses such capacity for performing the

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recited function. In re Ludtke, 441 F.2d 660, 169 USPQ 563 (CCPA 1971). In addition, where there is reason to believe that such functional limitation may be an inherent characteristic of the prior art reference, Applicant is required to prove that the subject matter shown in the prior art reference does not possess the characteristic relied upon. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986); In re Ludtke, 441 F.2d at 664, 169 USPQ at 566 (CCPA 1971); In re Shreiber, ___ F.2d at ___, 44 USPQ2d 1429 (Fed. Cir. 1997).

Allowable Subject Matter

9. Claims 27-32 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

Re claims 27-31, and 35, the independent claim includes “a drive member secured to a drive pulley, and the load sharing device comprises a belt engaged on the three drive pulleys, the load sharing device is configured to exert variable tension on the belt” in combination with the remaining claim limitation is not taught and/or made obvious by the prior art. Corrias et al. considered closest to related art, teaches and single-acting diaphragm actuator (80) that drives a rod (81) towards a support part (59). The actuator is supplied in parallel by a closed loop pneumatic feed line to balance the forces F of all three actuators (80) (Col. 5, lines 38-49). Corrias et al. does not provide any motivation that any other type of actuator may be used.

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Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMIKO D. BELLAMY whose telephone number is (571)272-2190. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on (571) 272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hezron Williams/
Supervisory Patent Examiner, Art Unit
2856

Tamiko Bellamy
/TB/
August 5, 2009